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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,659	01/03/2007	Ugo Piero Bianchi	293168USX PCT	4513
22850 7590 10/26/2010 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER WHEELER, THURMAN MICHAEL				
ART UNIT		PAPER NUMBER		
1619				
NOTIFICATION DATE		DELIVERY MODE		
10/26/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/585,659

Applicant(s)

BIANCHI ET AL.

Examiner

Thurman Wheeler

Art Unit

1619

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 October 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-9, 13 and 15-19.
Claim(s) withdrawn from consideration: 10, 11 and 14.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Tracy Vivemore/
Primary Examiner, Art Unit 1635

Continuation of 11, does NOT place the application in condition for allowance because: Applicants submit that Cavallotti has nothing to do with the present invention, which is directed to a dispersion of 7% to 40% of a least one imidoalkanepercarboxylic acid in water. Moreover, his initial, non-eutectic mixture of imidoalkanepercarboxylic acid and water has no non-ionic surfactant present, nor is any suggested. Further, Applicants submit that the Examiner has taken the position that it would have been obvious to add the nonionic surfactant of Barnes or Reinhardt to the Cavallotti "liquid formulation after the imidoalkane percarboxylic acids have been prepared and isolated by the procedure as taught by Cavallotti." Even if this were correct such addition would provide a composition with about 10% water, 88% imidoalkanepercarboxylic acid, and 1-2% nonionic surfactant." Thus, even if there were motivation to add a nonionic surfactant to the Cavallotti product and reduce the amount thereof from that suggested by Barnes and Reinhardt to that presently claimed, the claimed dispersion would not be provided. Further, Applicants submit that there is no reason one of ordinary skill in the art would modify Cavallotti by adding a nonionic surfactant.

Applicants' arguments filed 12 October 2010 have been fully considered but they are not persuasive, because one of ordinary skill in the art at the time of the invention would have recognized that after the aqueous dispersion of an imidoalkane percarboxylic acid was prepared as taught by Cavallotti, a liquid formulation comprising the percarboxylic acid and a surfactant could be prepared in accordance with the teachings of Barnes and Reinhardt. One skilled in the art would have been motivated to add a nonionic surfactant to a liquid formulation comprising an imidoalkane percarboxylic acid to provide a storage-stable liquid formulation as taught by Reinhardt. Particularly, Reinhardt discloses in claims 15 and 18 a composition wherein the content of percarboxylic acid is 0.5-30%, and wherein the suspension contains 2-30% by weight of the surfactant mixture, respectively. Accordingly, the concentration of both the imidoalkane percarboxylic acid and the nonionic surfactant can be readily adjusted by adding the appropriate amount of water as taught by Reinhardt, which is illustrated in Examples 1-7, column 4, where on line 68 the words: distilled water . . . to 100%, indicating that water up to 100% is added. Thus, one of ordinary skill in the art at the time of the invention would have had a reasonable amount of expectation of success to provide a liquid formulation as claimed by Applicants by following the teachings of Cavallotti, Barnes and Reinhardt, as a whole.

Applicants submit that application Serial No. 12039797 is clearly later-filed. According to MPEP 804 if a provisional nonstatutory obviousness-type double patenting rejection is the only rejection remaining in the earlier filed of the two pending applications the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.

Applicants' arguments have been fully considered but they are not persuasive, because the statement in MPEP 804 doesn't apply at present because the provisional nonstatutory obviousness-type double patenting rejection is not the sole rejection.